

## REMARKS

These remarks and claim amendments are submitted in response to the Office Action of October 3, 2003. In the Office Action, claims 1-5, 8-10 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,921,492 to Schultz et al. ("Schultz"). Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent 6,055,987 to Griesbach et al. ("Griesbach"). Claims 11 and 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent 3,604,421 to Pizzella ("Pizzella"). Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent 4,111,753 to Folsom et al. ("Folsom"). Finally, claims 1, 8, 9 and 10 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 4, respectively, of Schultz.

Applicants cancel claims 14-15 and offer the following remarks in favor of patentability. Applicants respectfully submit that the pending claims 1-13 are allowable over the art of record. A notice of allowance is respectfully requested.

### 35 U.S.C. § 102(b) Rejections

In the Office Action, claims 1-5, 8-10 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Schultz. A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *MPEP* § 2131.

Applicants' invention, as recited in independent claim 1, comprises "a plenum having a top wall, a bottom wall ..., a first side wall ..., and a second side wall. *Applicants' claim 1*. The "first wall extend[s] between said top and bottom walls and present[s] an outer periphery of said plenum." *Id.* The "second side wall extend[s] between said top and bottom walls and present[s] an inner periphery of said plenum." *Id.*

"[A] structure defin[es] a generally open facing adjacent to the inner periphery of said plenum." *Id.* The "walls defin[e] an internal plenum chamber in fluid communication with said open facing." *Id.* "Vacuum means operably coupled to said plenum ... creat[es] a reduced pressure within said plenum chamber, thereby drawing said by-products through said open facing." *Id.*

In contrast, Schultz discloses “a plenum having a top wall, a bottom wall ..., a side wall ..., and a structure.” *Schultz, col. 4, ll. 19-25*. The “side wall extend[s] between said top and bottom walls and present[s] an outer periphery of said plenum.” *Id.* The **“structure defin[es] a generally open facing presenting an inner periphery of said plenum.”** *Id.*

Thus, unlike Applicants’ invention as recited in claim 1, Schultz does not disclose a plenum that has a “a second side wall [that] extend[s] between said top and bottom walls and present[s] an inner periphery of said plenum,” and “a structure [that] defin[es] a generally open facing adjacent to the inner periphery of said plenum.” *Applicants’ claim 1*. Instead, Schultz discloses “a structure [that] defin[es] a generally open facing presenting an inner periphery of said plenum.” *Schultz, col. 4, ll. 19-25*.

For some surgical procedures, Applicants’ invention as recited in claim 1 offers a distinct advantage over Schultz. For example, because the Schultz open facing presents the inner periphery of the Schultz plenum, in surgical procedures involving a flap or ridge of tissue, the tissue may occlude the Schultz open facing. In contrast, for Applicants’ invention as recited in claim 1, the second wall presents the inner periphery of the plenum and, as a result, the flap or ridge of tissue is less likely to occlude the open facing.

Since Schultz does not disclose this advantageous feature of Applicants’ invention as recited in independent claim 1, Schultz does not anticipate independent claim 1 or its dependent claims 2-13. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the anticipation rejections of claims 1-5, 8-10 and 12.

### **35 U.S.C. § 103(a) Rejections**

In the Office Action, claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Griesbach, claims 11 and 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Pizzella, and claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Folsom.

In order for a combination of references to establish a case of prima facie obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references when combined must teach or suggest all the claim limitations. *MPEP* §2142.

As explained in the preceding section, Schultz does not teach or suggest certain advantageous features of Applicants' invention as recited in independent claim 1. Griesbach, Pizzella, and Folsom fail to remedy Schultz's deficiency because they do not disclose or teach a second inside wall that presents an inner periphery of the plenum and an open facing adjacent to the inner periphery. Accordingly, claim 1 and, as a result, its dependent claims 2-13 are not made obvious by the Schultz/Griesbach, Schultz/Pizzella, and the Schultz/Folsom combinations. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections of claims 6-7, 11 and 13-15.

#### **Obviousness-type Double Patenting Rejections**

Claims 1, 8, 9 and 10 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 4, respectively, of Schultz.

Applicants respectfully submit the Examiner has failed to establish a prima facie case of obviousness-type double patenting. For example, *MPEP* § 804 states,

[a] double patenting rejection of the obviousness-type is "analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. [citations omitted] Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. [citations omitted]

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows: (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue; (C) Determine the level of ordinary skill in the pertinent art; and (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

In an attempt to support the obviousness-type double patenting rejections, the Examiner cites *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993) and states, “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are merely broader than the application.” Besides failing to meet the above-quoted guidelines for establishing a prima facie case of obviousness-type double patenting, the Examiner misapplies *Goodman* and ignores the warning in the MPEP § 804 regarding domination by itself being insufficient to support double patenting.

In *Goodman*, the application contained generic claims that were broader than species claims that had already issued into a patent. *In re Goodman*, 29 USPQ2d at 2016. The broader generic claims were rejected under obviousness-type double patenting in view of the narrow species claims contained in the patent. *Id.*

In the present case, Applicants’ pending claims contain limitations not found in the Schultz patent. For example, as explained in the section of this response dealing with the

anticipation rejections, Applicant' pending claim 1 recites a "second side wall extending between said top and bottom walls and presenting an inner periphery of said plenum" and

"a structure defining a generally open facing adjacent to the inner periphery of said plenum." These limitations are not found in the claims of the Schultz patent. A comparison of the Schultz patent claims to Applicants' pending claims clearly reveals that the pending claims are narrower than the claims in the Schultz patent. Thus, the facts of *Goodman* are opposite those of the present case, and the Examiner has misapplied *Goodman*.

The MPEP warns against solely supporting an obviousness-type double patenting rejection by asserting that one set of claims is merely broader than another set of claims. For example, MPEP § 804 states,

[d]omination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986).

In view of the preceding discussion, Applicants respectfully submit that a prima facie case of obviousness-type double patenting has not been established in accordance with the requirements provided in MPEP § 804. Therefore, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

This response is being submitted on or before April 3, 2004, with a petition for a three-month extension of time to respond (from January 3, 2004 – April 3, 2004) along with a check in the amount of \$475 to cover the fee associated with the petition. It is believed that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 04-1420.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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